

### **REMARKS**

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of January 26, 2005.

All of the Examiner's objections and rejections are traversed.

Reexamination and reconsideration of the Application is requested.

### **The Office Action**

Claims 1-14 remain in this application.

Claims 5-8, 10, 11, 12, and 14 stand objected to due to informalities.

Claims 1, 7, 8, 9, and 12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,880,733 to Horvitz et al in view of U.S. Patent No. 6,661,426 to Jetha et al.

Claims 2 and 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,880,733 to Horvitz et al in view of U.S. Patent No. 6,661,426 to Jetha et al in further view of U.S. Patent No. 6,104,377 to Ledoux.

Claims 3 and 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,880,733 to Horvitz et al in view of U.S. Patent No. 6,661,426 to Jetha et al in further view of an article entitled "Networking Personal Computers with TCP/IP" authored by Hunt.

Claims 5, 6, 11, and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,880,733 to Horvitz et al in view of U.S. Patent No. 6,661,426 to Jetha et al in further view of U.S. Patent No. 6,466,831 to Shibata et al.

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,880,733 to Horvitz et al in view of U.S. Patent No. 6,661,426 to Jetha et al in further view of U.S. Patent No. 5,920,687 to Winner et al.

### **Objections to Claims 5-8, 10, 11, 12, and 14 are No Longer Appropriate**

The Examiner objected to claims 5-8, 10, 11, 12, and 14 due to informalities. Claims 12-14 have been amended to correct certain informalities. Applicants could not determine the informality in claims 5-8, 10, and 11. Applicants would appreciate if the Examiner would point to the informalities. The Examiner pointed out that in line 2 of claim 5 a colon should follow the word "includes" rather than a period

(Detailed Action, pg. 2). Upon close inspection of Applicant's version of the filed claims and the pre-grant published application, Applicant is unable to ascertain this informality.

**Claims 1, 7, 8, 9, and 12 are Non-Obvious**

In rejecting independent claim 1, the Office Action argues that Horvitz '773 provides "displaying at least one substantially opaque container object at a first display depth (Figure 4B) . . . ."

Applicants respectfully traverse this position. Horvitz clearly recites that the elements in Figure 4B are windows **410**. What is shown in Figures 4A, 4B and 4C is the operation of pushing back the windows **410**. However, the windows (*i.e.*, panels) are not opaque container objects as recited in claim 1 and particularly shown in figures of the present application, such as Figures 4 and 5. This is not a semantic difference, as the presentation to a user is based on the use of this container object within the three-dimensional space. As will be discussed in greater detail below, Applicants note that the existence of this container object and its description permit for looking inside the container object, which is not possible by any of the cited references.

For example, the analogy is opening a three-dimensional physical box and finding inside it certain contents (*i.e.*, content objects). This visual connotation is not taught or fairly considered by any of the cited art.

Thus, the display depth of Figure 4B of Horvitz '773 has nothing to do with a container, but has to do with viewing a flat panel on the three-dimensional screen. It is noted that Jetha '426 also does not disclose a container object (see col. 4, lines 37-43).

Applicants further respectfully traverse the position Jetha '426 teaches that the user will select a container to reveal "at least one content object contained therein (Figure 2:  $\beta$  programme 1)." Rather, in Jetha '426, Figure 2, the elements pointed to in the Office Action are clearly defined as display panels (*i.e.*, display panels 80-83). These panels are noted to "comprise a first portion  $a$  on which the displayed content appears, and a second portion  $\beta$  attached to the first and carrying ancillary data to identify the contents of each panel to the user. As shown, the first portion  $a$  of the respective display panels are opaque,

whereas the second portion  $\beta$  are translucent, revealing at least partially the contents of the overlaid first portion  $\alpha$  from the display panel behind. Thus, you are not looking into a container, but you are viewing the surface of the following window.

This does not provide any similarity of a user interface capability as shown and claimed in claim 1 of the present application.

As independent claims 7 and 12 also contain the above-noted concepts, it is submitted these claims are also distinguished from the cited art.

Additionally, the Examiner rejected claims 1, 7, 8, 9, and 12 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,880,733 to Horvitz et al in view of U.S. Patent No. 6,661,426 to Jetha et al.

In order to establish a *prima facie* case of obviousness, the Examiner must prove three basic criteria: 1) there must be some suggestion, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all the claim limitations. MPEP §2142.

The Jetha reference teaches a method and apparatus for displaying information from independent sources in multiple on screen panels. Indeed, the object of Jetha is to provide a mechanism to allow higher layers to be partially visible through translucent lower layers. However, neither Jetha nor Horvitz suggest that the teachings of either reference should be combined with the other. Furthermore, one of ordinary skill would not turn to Jetha to solve the problem present in the Horvitz reference. Jetha involves displaying 2-D panels from various external sources with one 2-D panel simply overlying another 2-D panel (see col. 4, lines 37-43). Horvitz involves displaying and accessing objects in a true 3-D workspace. One having ordinary skill in the art would not turn to a reference that teaches overlying 2-D panels with semi-transparent portions with a reference teaching how to manipulate objects in a true 3-D workspace environment. Manipulating and displaying panels in a true 3-D environment of Horvitz requires mathematical computations and matrix algebra that are not equivalent or analogous to those used in simply overlaying the 2-D display panels of Jetha. In fact, Jetha teaches that the display controller is preferably arranged to generate two dimensional images of the

three dimensional interface (Column 4, lines 37-38). The assertion that the motivation to combine the teachings of Horvitz and Jetha would be to provide an efficient way of minimizing windows is not a sufficiently particular finding as required by the Federal Circuit (*In re Rouffet*, see MPEP §2143.01). Therefore the requirements of proving a *prima facie* case of obviousness have not been met, and claim 1 should be allowed.

Since claims 7 and 12 were also rejected on a similar basis, those claims should be allowed in light of the analysis set forth above.

### **Claims 2 and 13 are Non-Obvious**

The Examiner rejected claims 2 and 13 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,880,733 to Horvitz et al in view of U.S. Patent No. 6,661,426 to Jetha et al in further view of U.S. Patent No. 6,104,377 to Ledoux.

To establish a *prima facie* case of obviousness there must be some suggestion, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The Ledoux reference does not suggest combining a dithering pattern method of reducing opacity with the method of displaying information panels in a 3-D workspace. In fact, Ledoux is strictly concerned with the application of a dithering pattern in a 2-D workspace environment as evidenced by a "row" and "column" pixel reference matrix (see Figure 2 of Ledoux '377). In this manner, Ledoux teaches away from using its method of reducing opacity in a 3-D environment.

Furthermore, it is unlikely that a person of ordinary skill in the art would combine the three references cited by the Examiner. Based on the previous analysis with respect to claim 1, there is no sufficient basis for motivation that would lead a person of ordinary skill to combine Horvitz and Jetha. The expectation that a person of ordinary skill would combine Horvitz, Jetha, and Ledoux is even less likely.

Since Ledoux provides no suggestion to combine, the requirements of proving a *prima facie* case of obviousness have not been met, and claim 2 should therefore be allowed.

Since claim 13 was rejected on a similar basis, it should also be allowed in light of the analysis set forth above.

**Claims 3 and 4 are Non-Obvious**

The Examiner rejected claims 3 and 4 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,880,733 to Horvitz et al in view of U.S. Patent No. 6,661,426 to Jetha et al in further view of an article entitled "Networking Personal Computers with TCP/IP" authored by Hunt.

Prior to an attempt to establish a *prima facie* case of obviousness, the reference which is relied upon as a basis for rejection, must either be in the field of applicant's endeavor or be reasonably pertinent to the particular problem with which the inventor was concerned. MPEP §2141.01(a).

The Hunt reference concerns accessing files and folders on a computer network. Hunt discloses the use of TCP/IP in establishing network connections among personal computers. In one aspect, Hunt discloses that password protection may be used (i.e. prompting the user for a password) in the process of establishing a connection with a remote computer, network folder, or network printer, etc. In contrast, the present invention is directed toward password protecting desktop oriented container objects. The password protection used in the present invention does not involve gaining access to a protected network connection via TCP/IP but rather to individual container objects present on the user's desktop. The Hunt reference is therefore non-analogous because Hunt is concerned with TCP/IP connectivity and not the manipulation of objects in a 3-D workspace environment. Nor is Hunt pertinent to the particular problem of password protecting desktop oriented container objects.

In addition, there is no suggestion to combine the Hunt reference with Jetha and Horvitz. A person having ordinary skill in the art would not look to an article disclosing how to network personal computers using TCP/IP to solve the problem of limiting access to container objects on a user's 3-D desktop workspace.

Therefore, the requirements of proving a *prima facie* case of obviousness have not been met, and claim 3 should be allowed.

Since claim 4 is dependent on claim 3, and because claim 3 should be allowed based on the analysis above, claim 4 should also be allowed.

**Claims 5, 6, 11, and 14 are Non-Obvious**

The Examiner rejected claims 5, 6, 11, and 14 under 35 U.S.C. §103(a) as

being unpatentable over U.S. Patent No. 5,880,733 to Horvitz et al in view of U.S. Patent No. 6,661,426 to Jetha et al in further view of U.S. Patent No. 6,466,831 to Shibata et al.

Shibata discloses a three axis control device which allows the user to select a more conventional two axis control mode or an improved three axis control mode. The Examiner cites Shibata for the proposition that it teaches "receiving a control signal indicating a user preference for one of (i) a two dimensional pointer operative to select objects at a first display depth, and (ii) a three dimensional pointer operative to select objects at the plurality of display depths." (Detailed Action, pg. 5). Shibata does not render claims 5, 6, 11, and 14 obvious for two reasons.

First, Shibata is non-analogous prior art. As mentioned previously, Shibata discloses a control device (e.g. a mouse) that has a user selectable 2-axis or 3-axis control mode. Shibata discloses the method of operation of the 3-axis control mode of the mouse (Figures 4-5D and Column 6 line 39 - Column 7 line 25). Shibata also teaches that under certain movements of the mouse body, a selected object can be rotated about an x, y, or z axis or the object can be zoomed in or out. However, such manipulations of the object are performed in a typical 2-D workspace of the computer's desktop. The objects are not translated within a 3-D desktop workspace. Furthermore, the user selectable 2-axis or 3-axis control is a hardware option on the mouse or control device itself. With respect to the present invention, the user preference of selecting the 2-D or 3-D pointer system is a software oriented control and not hardware based.

Secondly, even if Shibata were analogous, it does not provide any suggestion to combine the teachings of Horvitz, Jetha, and Shibata. A person having ordinary skill in the art would not turn to Shibata to solve the software related control method of switching between a 2-D and a 3-D workspace. The person of ordinary skill in the art would not look to Shibata because Shibata teaches an external hardware control device designed to rotate or zoom objects in a 2-D workspace.

As to claim 6, Shibata is not available as a reference for the same reasons outlined above. Shibata is non-analogous and lacks motivation to combine a user selectable 2-D/3-D workspace with the dynamically adjusting pointer of Horvitz.

Because claims 11 and 14 were rejected on a similar basis as claim 6, they too should be allowed.

As set forth above, the requirements of proving a *prima facie* case of obviousness have not been met and therefore claims 5, 6, 11, and 14 should be allowed.

**Claim 10 is Non-Obvious**

The Examiner rejected claim 10 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,880,733 to Horvitz et al in view of U.S. Patent No. 6,661,426 to Jetha et al in further view of U.S. Patent No. 5,920,687 to Winner et al.

Winner is directed to an improved method of handling z-layer data and z-buffers particularly in a graphical display environment. Winner, however, provides no motivation to combine in the present case. In fact, Winner teaches away from the present invention because Winner discloses the method of using an ActiveLayers register and a LayerPointer register such that if an incoming object meets certain criteria, the z values of that incoming object are inserted into a specified layer. The method disclosed by Winner acts to speed up conventional Z-layer buffer techniques (Column 3 lines 37-48). In contrast to the present invention, no such selectivity or determination is made based on the z-values of container objects or content objects. In this aspect, Winner teaches away from the present invention because Winner involves an improved method of handling and sorting z-layers while the present invention does not. In addition, the combination of Horvitz and Jetha with the improved method of handling z-layers of Winner does not result in the presently claimed invention.

Furthermore, it would be improper to combine the teachings of Winner, Jetha, and Horvitz in light of the analysis set forth previously with respect to claims 1, 7, 8, 9, and 12. Jetha is not a valid reference for purposes of 35 U.S.C §103(a) because it lacks a sufficient basis to form a suggestion to combine the teachings of Jetha with those of Horvitz.

As set forth above, the requirements of proving a *prima facie* case of obviousness have not been met and therefore claim 10 should be allowed.

New dependent claims 15-19 have been added to further emphasize distinguishing features between the cited art and the present application. It is submitted these concepts also are not taught or fairly considered by such art.

**CONCLUSION**

For the reasons detailed above, it is submitted all claims remaining in the application (Claims 1-19) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

No additional fee is believed to be required for this Amendment. However, the undersigned attorney of record hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Deposit Account No. 24-0037.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Mark Svat, at Telephone Number (216) 861-5582.

Respectfully submitted,

FAY, SHARPE, FAGAN,  
MINNICH & McKEE, LLP

*Apr 26<sup>th</sup> 2005*  
\_\_\_\_\_  
Date

*Mark Svat*  
\_\_\_\_\_  
Mark S. Svat  
Reg. No. 34,261  
1100 Superior Avenue, 7<sup>th</sup> Floor  
Cleveland, Ohio 44114-2579  
(216) 861-5582

N:\XERZ\200449\APT0000039V001.DOC